

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	David Boyd, et al.	Examiner:	Sana Al-Hashemi
Serial No.:	09/824,117	Group Art Unit:	2164
Filed:	April 2, 2001	Docket No.:	10003824-1
Title:	Envelope Printing Feature for Photo Filing System		

SUPPLEMENTAL APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the non-final Office Action mailed May 31, 2006, Applicants reinstate this appeal and file this Supplemental Appeal Brief.

The Office Action mailed May 31, 2006 re-opened prosecution and provided new grounds of rejection in response to the Appeal Brief filed on April 13, 2006. Applicants elect to reinstate this appeal and respond to the new grounds of rejection in this Supplemental Appeal Brief.

AUTHORIZATION TO DEBIT ACCOUNT

It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's deposit account no. 08-2025.

I. REAL PARTY IN INTEREST

The real party-in-interest is the assignee, Hewlett-Packard Company, a Delaware corporation, having its principal place of business in Palo Alto, California.

II. RELATED APPEALS AND INTERFERENCES

There are no known related appeals or interferences known to appellant, the appellant's legal representative, or assignee that will directly affect or be directly affected by or have a bearing on the Appeal Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 33 – 45 and 53 – 63 stand finally rejected. The rejection of claims 33 – 45 and 53 – 63 is appealed.

IV. STATUS OF AMENDMENTS

No amendments were made after receipt of the Final Office Action. All amendments have been entered. Claims 1 – 32 were previously canceled, and claims 46 – 52 were previously withdrawn. Claims 33 – 45 and 53 – 63 are pending in the application and subject of this appeal.

The Office Action mailed May 31, 2006 re-opened prosecution and provided new grounds of rejection in response to the Appeal Brief filed on April 13, 2006. Applicants elect to reinstate this appeal and respond to the new grounds of rejection in this Supplemental Appeal Brief

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following provides a concise explanation of the subject matter defined in each of the claims involved in the appeal, referring to the specification by page and line number and to the drawings by reference characters, as required by 37 C.F.R.

§ 41.37(c)(1)(v). Each element of the claims is identified by a corresponding reference to the specification and drawings where applicable. Note that the citation to passages in the specification and drawings for each claim element does not imply that the limitations from the specification and drawings should be read into the corresponding claim element or that these are the sole sources in the specification supporting the claim features.

Claim 33

A method comprising:
 using a camera to capture at least one image (FIG. 1, #101: p. 6, lines 1-16);
 using said camera to capture information associated with said image, wherein said information is stored in a database (FIG. 1, #101-106: p. 6, line 7 – p. 7, line 27); and
 using said information to generate a physical label having an identifier, wherein the label is adapted to be affixed to a storage device that is adapted to hold printed copies of the plurality of images (FIG. 1, #108-110: p. 8, lines 1-24).

Claim 42

The method of claim 33, further comprising:
 searching the database with a query to locate a printed copy of one image of the plurality of images (FIG. 2, #201: p. 8, line 25 – p. 9, line 7);
 providing the identifier associated with the one image (FIG. 2, #202-203: p. 9, lines 8-14);
 locating the storage container with the label having the identifier (p. 9, lines 13-16);
 searching the storage container for the printed copy of the one image (p. 9, lines 13-16).

Claim 44

The method of claim 33 further comprising:
forming a thumbnail representation of the image on the label (p. 8, lines 14-15).

Claim 45

The method of claim 44, further comprising:
searching the database with a query to locate the printed copy of the image (FIG. 2, #201-202: p. 8, line 25 – p. 9, line 9); and
providing the thumbnail representation of the image (FIG. 2, #203: p. 9, lines 9-11).

Claim 53

A method comprising:
generating information identifying an image at the time said image is captured (FIG. 1, #101: p. 6, lines 1-16);
automatically producing meta-data associated with said image (FIG. 1, #103: p. 6, lines 8-16; and p. 7, lines 6-16);
providing the meta-data into a database (FIG. 1, #105: p. 7, lines 21-22);
generating a physical label that is adapted to be affixed to a storage device adapted to hold a printed copy of said image, wherein said label has an identifier generated from said identifying information (FIG. 1, #108-110: p. 8, lines 1-24); and
providing said identifier into said database (p. 8, lines 8-14).

Claim 54

The method of claim 53 wherein said identifying information is automatically generated by a device capturing said image. (p. 7, lines 6-16)

Claim 55

The method of claim 53 further comprising:
providing a thumbnail representation of the image into the database (FIG. 1, #105: p. 7, lines 21-22); and
printing the thumbnail representation on the label (p. 8, lines 14-16).

Claim 59

A method comprising:

capturing a plurality of images with a digital camera (FIG. 1, #101: p. 6, lines 1-16);

inputting, from a user into said digital camera, user data associated with each said image (FIG. 1, #104: p. 7, lines 17-20);

automatically generating, with said digital camera, meta-data associated with each said image, wherein said meta-data comprises said user data, and wherein said meta-data for each said image is generated at a time said image is captured (FIG. 1, #103: p. 6, lines 8-16; and p. 7, lines 6-16);

providing each said image and its associated meta-data into a computer (FIG. 1, #105: p. 7, lines 21-22); and

generating a label to affix to a storage device for holding a printed copy of said images, wherein said label identifies said printed copies with an identifier image generated from said meta-data (FIG. 1, #108-110: p. 8, lines 1-24).

Claim 60

The method of claim 59 further comprising:

generating a thumbnail of said image on said label (p. 8, lines 14-16).

Claim 63

The method of claim 59 further comprising:

storing, in said computer, said meta-data, said user data, and said identifier (FIG. 1, #105: p. 7, lines 21-22).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

I. Claims 33-37, 43, 44, and 59 are rejected under 35 USC § 102(e) as being anticipated by USPN 6,629,104 (Parulski).

II. Claims 38, 40-42, 45, 53-55, and 60-63 are rejected under 35 USC § 103(a) as being unpatentable USPN 6,629,104 (Parulski) in view of USPN 6,483,570 (Slater).

III. Claims 39 and 56-58 are rejected under 35 USC § 103(a) as being unpatentable over USPN 6,629,104 (Parulski) in view of USPN 6,483,570 (Slater) and USPN 6,426,801 (Reed).

IV. Claim 39 is rejected under 35 USC § 103(a) as being unpatentable over USPN 6,629,104 (Parulski) in view of USPN 6,483,570 (Slater) and USPN 6,813,395 (Kinjo).¹

¹ On page 8 of the Office Action dated May 31, 2006, claims 56-58 are rejected under Parulski, Slater, and Reed. On page 9, however, the Office Action argues that claims 56-58 are unpatentable over Parulski, Slater, and Kinjo (USPN 6,813,395).

VII. ARGUMENT

The rejection of claims 33 – 45 and 53 – 63 is improper, and Applicants respectfully requests withdraw of this rejection.

The claims do not stand or fall together. Instead, Applicants present separate arguments for various independent and dependent claims. Each of these arguments is separately argued below and presented with separate headings and sub-heading as required by 37 C.F.R. § 41.37(c)(1)(vii).

I. Claims Rejections: 35 USC§ 102(e)

Claims 33-37, 43, 44, and 59 are rejected under 35 USC § 102(e) as being anticipated by USPN 6,629,104 (Parulski). This rejection is traversed.

Claim 33

As a first example, claim 33 recites using a camera to capture both an image and information associated with the image. The claim then recites that this information is used to generate a “**physical** label ... adapted to be affixed to a storage device” (emphasis added). Parulski does not teach this recitation. The Office Actions cites Parulski at column 3, lines 14-26. Applicants respectfully disagree.

Column 3, lines 14-26 in Parulski discusses adding electronic labels to images stored in a computer. In Parulski, however, the labels are electronic. Parulski never teaches or even suggests that such labels are “physical labels.”

Column 3, lines 14-26 are directed to a flow diagram for a user to launch a software program for creating and storing labels in a computer. Parulski explains that these labels are electronic, not physical, and electronically stored in a database as metadata:

Operation 150 causes user labels to be stored in a metadata database. This completes the process of developing the database of pre-assigned metadata labels personalized for the particular user. (See Parulski at 3: 5-8).

Thus, Parulski does not teach generating “physical” labels. Applicants respectfully state that anticipation is established only when a single prior art reference discloses each and every element of a claimed invention united in the same way. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444 (Fed. Cir. 1984).

For at least these reasons, claim 33 is not anticipated by Parulski. Applicants respectfully request reversal of this rejection.

As a second example, claim 33 recites that the labels are “affixed” to a storage device. Parulski does not teach this recitation. The Office Actions cites Parulski at column 3, lines 14-26. Applicants respectfully disagree.

Column 3, lines 14-26 in Parulski discusses adding electronic labels to images stored in a computer. In Parulski, however, the labels are electronic. Parulski never teaches or even suggests that such electronic labels can somehow be “affixed” to a storage device.

As noted above, column 3, lines 14-26 are directed to a flow diagram for a user to launch a software program for creating and storing labels in a computer. Parulski explains that these labels are electronic and electronically stored in a database as metadata (see Parulski at 3: 5-8). Parulski never teaches or even mentions whatsoever that such electronically stored metadata labels are somehow “affixed to a storage device.”

Thus, Parulski does not teach affixing physical labels to a storage device. Applicants respectfully state that for a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

For at least these reasons, claim 33 is not anticipated by Parulski. Applicants respectfully request reversal of this rejection.

As a third example, claim 33 recites capturing an image with a camera and then using the “camera to capture information associated with said image.” The Office Action argues that this recitation is taught in Parulski at column 2, lines 58-63. Applicants respectfully disagree.

Column 2, lines 58-63 in Parulski teaches executing a software program with a computer (“Operation block 100 discloses a user inserting an auto-launch CD-ROM into a CD-ROM drive of a computer in order to install software that implements the method of

the present invention.” See 2: 49-55). The computer prompts a user to create electronic labels for images that will be captured with a separate camera at a later time.

Parulski is in direct contrast to the recitations of the claim. Claim 33 recites that the **camera captures information** associated with the image. By direct contrast, Parulski teaches that a computer software program interacts with a user to obtain information about future images. In other words, Parulski teaches that a computer, not a camera, receives information about labels. The computer in Parulski is not a camera. The computer does not “capture” an image. Further, in Parulski, a user inputs the labels into a computer **before** the images are captured.

Thus, Parulski does not teach a camera that captures information associated with the image. Applicants respectfully state that anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985).

For at least these reasons, claim 33 and its dependent claims are allowable over Slater in view of Parulski.

Claim 44

Claim 44 recites “forming a thumbnail representation of the image on the label.” The Office Action argues that this recitation is taught in Parulski at column 4, lines 49-52. Applicants strongly disagree.

Column 4, lines 49-52 in Parulski merely teaches that a digital camera determines metadata items. This section of Parulski is not related whatsoever to the claim recitations. Claim 44 recites forming a thumbnail representation of the image on the label. Parulski never teaches or even suggests that a label includes a thumbnail of the image. Parulski is completely silent about putting a thumbnail on a label.

For at least these reasons, claim 44 is allowable over Parulski. Applicants respectfully request reversal of this rejection.

Claim 59

As a first example, claim 59 recites “generating a label to affix to a storage device.” Parulski does not teach this recitation. The Office Actions cites Parulski at column 3, lines 14-26. Applicants respectfully disagree.

Column 3, lines 14-26 in Parulski discusses adding electronic labels to images stored in a computer. In Parulski, however, the labels are electronic. Parulski never teaches or even suggests that such electronic labels can somehow be “affixed” to a storage device.

As noted above, column 3, lines 14-26 in Parulski are directed to a flow diagram for a user to launch a software program for creating and storing labels in a computer. Parulski explains that these labels are electronic and electronically stored in a database as metadata (see Parulski at 3: 5-8). Parulski never teaches or even mentions whatsoever that such electronically stored metadata labels are somehow “affixed to a storage device.”

Thus, Parulski does not teach affixing labels to a storage device. Applicants respectfully state that for a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

For at least these reasons, claim 59 is not anticipated by Parulski. Applicants respectfully request reversal of this rejection.

As a second example, claim 59 recites that the label is affixed to a storage device “for holding a printed copy of said images.” The Office Actions cites Parulski at column 5, lines 14-17. Applicants respectfully disagree.

Column 5 in Parulski teaches that images are captured with a digital camera and then downloaded to a computer. Lines 14-17 in Parulski teach that the computer communicates with a printer, and the printer prints copies of the images. By contrast, claim 59 recites that a label is affixed to a storage device that holds a copy of the image. Where is a teaching of the storage device for holding printed copies in Parulski? Where is a teaching of a label affixed to a storage device that holds printed copies in Parulski? Such teachings do not exist.

Thus, Parulski does not teach a label that is affixed to a storage device “for holding a printed copy of said images.” Applicants respectfully state that in order for a

prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he elements must be arranged as required by the claim,” see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

For at least these reasons, claim 59 is not anticipated by Parulski. Applicants respectfully request reversal of this rejection.

As a third example, claim 59 recites “inputting, from a user into said digital camera, user data associated with each said image.” The Office Action does not even address these claim recitations. Applicants argue that nowhere does Parulski teach or even suggest such recitations.

For at least these reasons, claim 59 is not anticipated by Parulski. Applicants respectfully request reversal of this rejection.

As a fourth example, claim 59 recites “automatically generating, with said digital camera, meta-data associated with each said image, wherein said meta-data comprises said user data, and wherein said meta-data for each said image is generated at a time said image is captured.” The Office Action does not even address these claim recitations.

For at least these reasons, claim 59 is not anticipated by Parulski. Applicants respectfully request reversal of this rejection.

II. Claim Rejections: 35 USC § 103(a)

Claims 38, 40-42, 45, 53-55, and 60-63 are rejected under 35 USC § 103(a) as being unpatentable USPN 6,629,104 (Parulski) in view of USPN 6,483,570 (Slater). This rejection is traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. For at least the following reasons, Applicants assert that the rejection does not satisfy these criteria.

Overview of Parulski & Slater

As a precursor to the arguments, Applicants provide an overview of Parulski and Slater.

Parulski teaches methods for adding personal information to images so the images can be categorized in a database (1: 58-61). A user is asked a series of personal questions in order to create metadata labels for tracking images (5: 65 – 6: 16). These labels are stored and later assigned to images that the user captures and downloads (6: 16-19).

Slater teaches apparatus and methods for processing film at photofinishing laboratories (see FIGS. 1A and 1B). Customers place undeveloped film in an envelope and give the envelope to a retailer for developing (7: 1-25). The envelopes are sorted, and the film undergoes extensive processing in order to develop the film (8: 1-67). During development of the film, an operator views images on a display and provides a content descriptor or content identification for the images (11: 12-54). A determination is then made whether a match occurs between the content identification and a stored image content identification (12: 10-53).

No Suggestion/Motivation to Modify/Combine References

For at least the following reasons, no suggestion or motivation exists to modify or combine Parulski in view of Slater.

First, Applicants argue that no teaching or suggestion exists to make the combination because the references are directed to completely different inventions. Slater is directed to apparatus and methods for processing film at photofinishing laboratories. FIGS. 1A and 1B show such a photofinishing laboratory. By contrast, Parulski is directed methods for adding personal information to images so the images can be categorized in a database (1: 58-61). A user is asked a series of personal questions in order to create metadata labels for tracking images (5: 65 – 6: 16). These labels are stored and later assigned to images that the user downloads (6: 16-19).

The Examiner must provide *objective evidence*, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention

absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Such teaching or suggestion does not exist.

Second, Applicants argue that no teaching or suggestion exists to make the combination because the references are directed to solving completely different problems. In Slater, the Background section discusses that after a photographer gives a roll of film to a processing laboratory, the photographer may want to display the images on products other than paper. “It would be desirable if some way was provided to readily make available to a photographer a type of produce or service she might already want, with little or no effort to locate such a product or service on the photographer’s part” (2: 12-15). By contrast, Parulski solves a completely different problem. In Parulski, the Background section discusses the problems with conventional software applications for categorizing images. “Unfortunately, these conventional software applications make it difficult for an untrained consumer to categorize their images in a way that enables them to later locate their favorite images of a selected subject” (1:47-51).

To establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). In light of the completely different inventions and problems being solved in Slater and Parulski, no suggestion or motivation exists to combine or modify these references.

For at least these reasons, Applicants respectfully assert that a *prima facie* case of obvious has not been established.

No Reasonable Expectation of Success

No reasonable expectation of success has been established for modifying Parulski with the teachings of Slater to arrive at the recitations of the claims. In other words, even assuming *arguendo* that Parulski and Slater are combinable (which they are not), the combination will not yield a reasonable expectation of success.

Slater teaches apparatus and methods for processing film at photofinishing laboratories. FIGS. 1A and 1B show the complex nature of such processing. Parulski teaches methods for users to add personal information to images so the images can be categorized in a database. Users are asked a series of personal questions in order to create metadata labels for tracking images. The complex undertakings in processing film rolls taught in Slater cannot successfully be combined with the method taught in Parulski for personalizing information in a database.

In view of these deficiencies, the Office Action has failed to establish a reasonable expectation of success with a combination or modification of Parulski and Slater. Therefore, the *prima facie* case of obviousness has not been established.

Hindsight Construction (Picking and Choosing)

The Office Action combines two unrelated references (Parulski and Slater) to allegedly obviate the claims. Applicants respectfully assert that the Examiner is using knowledge of Applicants' invention and then performing hindsight reconstruction to show the various claim elements. In other words, the Office Action is picking and choosing teachings from numerous isolated references. On this subject, the case law is clear: One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

For at least these reasons, a *prima facie* case of obvious has not been established.

All Elements Not Taught or Suggested

All of the elements of the claims are not taught or suggested in Parulski and Slater. In other words, evening assuming *arguendo* that Parulski and Slater are successfully combinable (which they are not), the alleged combination does not teach or suggest all the elements in the claims. Examples for various independent and dependent claim groups are provided below.

Claim 42

As one example, claim 42 recites “searching a database with a query to locate a printed copy of one image of the plurality of images.” The Office Action argues that this recitation is taught in Slater at column 6, lines 31-43. Applicants respectfully disagree.

Column 6, lines 31-43 in Slater teaches how to match two different stored images (i.e., a generated image content identification with a stored image content identification). This section of Slater has nothing whatsoever to do with **locating a printed copy** of an image. Again, Slater is concerned with matching two electronic images, not locating a printed copy among a plurality of printed copies in a storage device.

For at least these reasons, claim 42 is allowable over Parulski in view of Slater.

As another example, claim 42 recites “searching the storage container for the printed copy of the one image.” The Office Action argues that this recitation is taught in Slater at column 7, lines 30-35. Applicants respectfully disagree.

Column 7, lines 30-35 in Slater teaches that retail stores can develop film for customers. When a customer deposits film at the retail store, the customer puts the film in an envelope and writes identifying information (example, his/her address) on the envelope. This section of Slater teaches or suggests nothing about searching a storage container for a printed copy of an image.

For at least these reasons, claim 42 is allowable over Parulski in view of Slater.

Claim 45

As one example, claim 45 recites “searching the database with a query to locate the printed copy of the image.” The Office Action argues that this recitation is taught in Slater at column 6, lines 31-43. Applicants respectfully disagree.

Column 6, lines 31-43 in Slater teaches how to match two different stored images (i.e., a generated image content identification with a stored image content identification). This section of Slater has nothing whatsoever to do with **locating a printed copy** of an image. Again, Slater is concerned with matching two electronic images, not locating a printed copy among a plurality of printed copies in a storage device.

For at least these reasons, claim 45 is allowable over Parulski in view of Slater.

As another example, claim 45 recites “providing the thumbnail representation of the image.” The Office Action argues that this recitation is taught in Slater at column 10, lines 19-27. Applicants respectfully disagree.

Column 10, lines 19-27 in Slater describes an image preview station wherein an operator can view images on a computer screen. At this cited location, Slater never teaches or even suggests that the images on the computer display are **thumbnails**. Instead, Slater merely says that previews of images are provided on a display.

For at least these reasons, claim 45 is allowable over Parulski in view of Slater.

Claim 53

As one example, claim 53 recites generating information that identifies a captured image. The claim then recites “generating **physical** label that is adapted to be affixed to a storage device adapted to hold a printed copy of said image” (emphasis added). Slater in view of Parulski does not teach or suggest this recitation. The Office Actions cites Slater at column 6, lines 1-8 and Parulski at column 3, lines 14-26. Applicants respectfully disagree.

Column 6, lines 1-8 of Slater discusses different examples for “content identification.” In Slater, the term “content identification” means identifying one or more objects in a scene of an image (5: 51-53). Content identification has nothing whatsoever to do with a physical label or affixing a physical label to a storage device.

Column 3, lines 14-26 in Parulski discusses adding labels to images. In Parulski, however, the labels are electronic. Parulski never teaches or even suggests that such labels are physical labels or that such labels can be affixed to a storage device.

For at least these reasons, claim 53 and its dependent claims are allowable over Parulski in view of Slater.

As another example, claim 53 recites “generating information identifying an image **at the time said image is captured**” (emphasis added). In other words, when an image is captured, information identifying the image is generated. Slater in view of Parulski does not teach or suggest this recitation. The Office Actions cites Parulski at column 2, lines 28-38. Applicants respectfully disagree.

Column 2, lines 28-38 of Parulski are a brief description of various drawings. This section of Parulski has nothing whatsoever to do with the noted recitations.

For at least these reasons, claim 53 and its dependent claims are allowable over Parulski in view of Slater.

As yet another example, claim 53 recites “**automatically** producing meta-data associated with said image” (emphasis added). Slater in view of Parulski does not teach or suggest this recitation. The Office Actions cites Parulski at column 3, lines 9-13. Applicants respectfully disagree.

Column 3, lines 9-13 of Parulski teaches that a user enters personal information. This information is used to generate labels that are stored as meta-data. In Parulski, the meta-data is not **automatically produced**. Instead, a user enters the meta-data.

For at least these reasons, claim 53 and its dependent claims are allowable over Parulski in view of Slater.

Claim 54

Claim 54 recites generating information identifying an image at the time the image is captured. This identifying information is “automatically generated by a device capturing said image.” Parulski in view of Slater does not teach or suggest this recitation. The Office Actions cites Slater at column 14, lines 6-8. Applicants respectfully disagree.

Column 14, lines 6-8 of Slater teaches that after undeveloped film is sent to a processing laboratory, an operator can identify the images on a display and use a computer to provide the images with a content identification. This teaching in Slater is in direct contrast to the claim recitations. Claim 54 states that the identifying information is generated by the device that captures the image. In Slater, a user uses a camera to capture an image. This camera, however, is not the same device used to generate the identification discussed in Slater at column 14, lines 6-8.

For at least these reasons, claim 54 is allowable over Parulski in view of Slater.

Claim 55

Claim 55 recites “printing the thumbnail representation on the label.” The Office Action argues that this recitation is taught in Slater at column 11, lines 30-46. Applicants respectfully disagree.

Column 11, lines 30-46 in Slater describes that an operator in a finishing laboratory can view thumbnail images on a computer display. Slater never teaches or even suggests that these thumbnail images are printed on a label. Slater is completely silent about putting a thumbnail on this label.

For at least these reasons, claim 55 is allowable over Parulski in view of Slater.

Claim 60

Claim 60 recites “generating a thumbnail of said image on said label.” The Office Action argues that this recitation is taught in Slater at column 11, lines 20-30. Applicants respectfully disagree.

Column 11, lines 20-30 in Slater describes that an operator in a finishing laboratory can view thumbnail images on a computer display. Slater never teaches or even suggests that these thumbnail images are printed on a label. Slater is completely silent about putting a thumbnail on this label.

For at least these reasons, claim 60 is allowable over Parulski in view of Slater.

Claim 63

Claim recites storing in a computer three different elements: meta-data, user data, and an identifier. The Office Action argues that this recitation is taught in Parulski at column 6, lines 1-8. Applicants respectfully disagree.

Column 6, lines 1-8 in Parulski teaches that users are asked personal questions in order to generate meta-data labels. These labels are derived from emotional judgment of the user. Parulski does teach storing meta-data. By contrast, claim 63 recites three different elements: meta-data, user data, and an identifier. Parulski does not teach or suggest all three of these elements.

For at least these reasons, claim 63 is allowable over Parulski in view of Slater.

III. Claim Rejections: 35 USC § 103

Claims 39 and 56-58 are rejected under 35 USC § 103(a) as being unpatentable over USPN 6,629,104 (Parulski) in view of USPN 6,483,570 (Slater) and USPN 6,426,801 (Reed). These rejections are traversed.

Dependent claims 39 depends from independent claim 33, and dependent claims 56-58 depend from independent claim 53. As discussed in sections I and II, independent claims 33 and 53 are allowable over Slater and Parulski. Reed fails to cure the deficiencies of Slater and Parulski. Thus, for at least the reasons state above, claims 39 and 56-58 are allowable over the art of record.

IV. Claim Rejections: 35 USC § 103

Claim 39 is rejected under 35 USC § 103(a) as being unpatentable over USPN 6,629,104 (Parulski) in view of USPN 6,483,570 (Slater) and USPN 6,813,395 (Kinjo). This rejection is traversed.

Dependent claims 39 depends from independent claim 33. As discussed in section I, independent claim 33 is allowable Parulski. Slater and Kinjo fail to cure the deficiencies of Parulski. Thus, for at least the reasons state above, claims 39 is allowable over the art of record.

CONCLUSION

In view of the above, Applicants respectfully request the Board of Appeals to reverse the Examiner's rejection of all pending claims.

Any inquiry regarding this Amendment and Response should be directed to Philip S. Lyren at Telephone No. 832-236-5529. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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VIII. Claims Appendix

33. A method comprising:
using a camera to capture at least one image;
using said camera to capture information associated with said image, wherein said information is stored in a database; and
using said information to generate a physical label having an identifier, wherein the label is adapted to be affixed to a storage device that is adapted to hold printed copies of the plurality of images.
34. The method of claim 33 wherein said image is a digital image, further comprising:
storing each image of the plurality of images in said database.
35. The method of claim 33, wherein capturing said information comprises:
forming metadata during said capture of said image.
36. The method of claim 33, wherein capturing said information comprises:
accepting said information from a user.
37. The method of claim 33 wherein the information is at least one of:
GPS coordinates;
a time;
a date;
camera information;
an audio file;
at least one keyword;
a description of subject matter of the image; and
an event associated with the image.

38. The method of claim 33 wherein the storage device is selected from the group consisting of:

- an envelope;
- an album; and
- a box.

39. The method of claim 33, further comprising:
forming at least a portion of the plurality of images by a digital camera.

40. The method of claim 33, further comprising:
forming at least a portion of the plurality of images by a non-digital camera; and
converting the at least a portion of the plurality of images into digital form.

41. The method of claim 33, further comprising:
placing the label on the storage device; and
placing printed copies of the plurality of images in the storage device.

42. The method of claim 33, further comprising:
searching the database with a query to locate a printed copy of one image of the plurality of images;
providing the identifier associated with the one image;
locating the storage container with the label having the identifier;
searching the storage container for the printed copy of the one image.

43. The method of claim 42 wherein the query comprises at least one of:
GPS coordinates;
a time;
a date;
camera information;
an audio file;
at least one keyword;
a description of subject matter of the one image; and
an event associated with the one image.

44. The method of claim 33 further comprising:
forming a thumbnail representation of the image on the label.
45. The method of claim 44, further comprising:
searching the database with a query to locate the printed copy of the image; and
providing the thumbnail representation of the image.
46. (Withdrawn) A system comprising:
a storage container that holds printed copies of a plurality of images;
a printer that provides a label having an identifier, wherein the label is affixed to
the storage container; and
a database for holding information associated with at least one image of the
plurality of images, and associates each of the images of the plurality of images with the
identifier.
47. (Withdrawn) The system of claim 46, wherein the database also stores
each image of the plurality of images.
48. (Withdrawn) The system of claim 46, wherein the information is at least
one of:
GPS coordinates;
a time;
a date;
camera information;
an audio file;
at least one keyword;
a description of subject matter of the image; and
an event associated with the image.

49. (Withdrawn) The system of claim 46, wherein the storage device is selected from the group consisting of:

- an envelope;
- an album; and
- a box.

50. (Withdrawn) A system for storing a printed copy of an image, comprising:

- means for providing information associated with the image;
- means for storing a printed copy of the image;
- means for generating a label having an identifier, wherein the label is adapted to be affixed to the means for storing; and
- means for storing the information and for associating the identifier with the image.

51. (Withdrawn) The system of claim 50, wherein the information is at least one of:

- GPS coordinates;
- a time;
- a date;
- camera information;
- an audio file;
- at least one keyword;
- a description of subject matter of the image; and
- an event associated with the image.

52. (Withdrawn) The system of claim 51, further comprising:
means for searching the means for storing the information and for associating the identifier with the image to locate the means for storing a printed copy of the image via the identifier;

wherein the means for searching uses a query that includes at least a portion of the information.

53. A method comprising:
generating information identifying an image at the time said image is captured;
automatically producing meta-data associated with said image;
providing the meta-data into a database;
generating a physical label that is adapted to be affixed to a storage device
adapted to hold a printed copy of said image, wherein said label has an identifier
generated from said identifying information; and
providing said identifier into said database.

54. The method of claim 53 wherein said identifying information is
automatically generated by a device capturing said image.

55. The method of claim 53 further comprising:
providing a thumbnail representation of the image into the database; and
printing the thumbnail representation on the label.

56. The method of claim 53 wherein the meta-data includes global position
system (GPS) coordinates acquired at a time when the image is produced.

57. The method of claim 53 further comprising:
searching for the image in the database by submitting a query to the database,
wherein the query includes criteria associated with the meta-data.

58. The method of claim 57 further comprising:
displaying a thumbnail representation of the image upon matching the query to
the image in the database.

59. A method comprising:
capturing a plurality of images with a digital camera;
inputting, from a user into said digital camera, user data associated with each said image;
automatically generating, with said digital camera, meta-data associated with each said image, wherein said meta-data comprises said user data, and wherein said meta-data for each said image is generated at a time said image is captured;
providing each said image and its associated meta-data into a computer; and
generating a label to affix to a storage device for holding a printed copy of said images, wherein said label identifies said printed copies with an identifier image generated from said meta-data.
60. The method of claim 59 further comprising:
generating a thumbnail of said image on said label.
61. The method of claim 59 further comprising:
organizing said images on said computer using said meta-data.
62. The method of claim 59 further comprising:
automatically creating, with said computer, said identifier.
63. The method of claim 59 further comprising:
storing, in said computer, said meta-data, said user data, and said identifier.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.